



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/524,638	02/16/2005	Dieter Flockerzi	26445U	1480
34375 7590 06/20/2008 NATH & ASSOCIATES PLLC 112 South West Street Alexandria, VA 22314				
EXAMINER DESAL, RITA J				
ART UNIT 1625		PAPER NUMBER		
MAIL DATE 06/20/2008		DELIVERY MODE PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/524,638

**Applicant(s)**

FLOCKERZI, DIETER

**Examiner**

Rita J. Desai

**Art Unit**

1625

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 March 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 3-5, 8-11, 13 and 15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3-5, 8-11, 13 and 15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI-108)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Claims pending 3-5, 8-11, 13 and 15 are pending.

Applicants have cancelled the broad claims and amended some claims to try and overcome the 35 USC 112 rejection.

The rejection has been withdrawn with respect to some of the claims.

The rejection has been maintained over claim 15. There is no data in the specifications to indicate that these compounds can treat the list of diseases as given in claim 15 such as asthma , psoriasis , atopic eczema , COPD and bronchitis.

The specifications just has some IC50 data for PDE4 and 3 inhibition for some 28 compounds that were made. This does not give enough guidance that the diseases as listed in the claim 15 can be treated.

The rejection hence has been partially withdrawn with respect to the solvates and R groups. The rejection of the claims under 35 USC 103 has been withdrawn and it has been modified into a new rejection using WO 02/066476, Gutterer et al further in view.

The double patenting rejection over claims 1-13 of U.S. Patent No. 6008215, claims 1-10 of US 6306869 and claims 1-12 of US 6143759 in view of each other has also been modified in view of US 6936622 ( WO 02/066476.)

New rejection.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

Art Unit: 1625

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3-5, 8-11, 13 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims recite the term "radical " and it is unclear how these groups are radical.

Applicants can overcome this by either deleting the term radical , and inserting "group" wherever appropriate.

### ***Claim Rejections - 35 USC § 103***

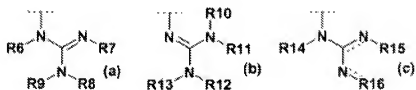
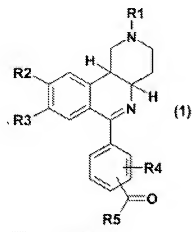
The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3-5,8-11, 13 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over and being obvious over WO 02/066476 Gutierrez et al. and US 6306869 and 6143759 Flockeral et al and WO 98/21208 Gutierrez et al (US 6008215) also WO 98/40382

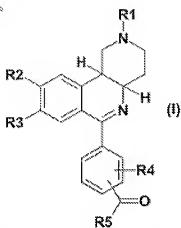
Art Unit: 1625

Applicants compounds are drawn to the core

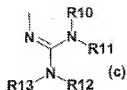
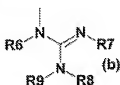
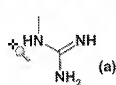
*Scope & Content of Prior Art MPEP 2141.01*

WO 02/066476, (US6,936,622) discloses similar compounds with the similar R5 group.

Art Unit: 1625

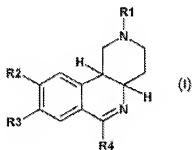


R5 is a radical of the formula (a), (b) or (c)



Chem. Abstr. 1980, 101, 101, 101

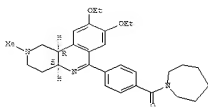
Other prior art references teaches similar compounds with the same core.



wherein R4 is a phenyl

substituted by CO-R7, COR8, with R8 being NR81R82 and they forming a ring.

One of the species amongst other (piperidine, morpholine etc) is given by the following.



US 6306869 and 6143759 Flockeral et al , US6,936,622also teach compounds with the same core only difference being the substituents on the R4 phenyl ring.

Prima Facie Obviousness , Rational and Motivation MPEP 2142-2413

The use / utility is the same for all the compounds . A very similar core is taught in the WO 02/066476 . There are several other compounds taught with the same core. As the R5 is clearly taught one of skill in the art would have been motivated to put the R5 of WO'467 onthe toobtain the compound of the invention.

This rejection can also really be made only on the primary reference WO 02/066476 which teaches almost the same group. See supra.

The Double patenting rejection has also been modified.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 3-5, 8-11, 13 and 15 are rejected on the ground of nonstatutory obviousness-type

double patenting as being unpatentable over  
claims 1-13 of U.S. Patent No. 6008215,  
claims 1-10 of US 6306869 and  
claims 1-12 of US 6143759  
in view of each other and WO 02/066476 (US6,936,622) .

See the rejection of 103 above for the reasoning.

### *Conclusion*

Claims 3-5, 8-11, 13 and 15 are rejected.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rita J. Desai whose telephone number is 571-272-0684. The examiner can normally be reached on Monday - Friday, flex time..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Andres can be reached on 571-272-0867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Art Unit: 1625

Rita J. Desai  
Primary Examiner  
Art Unit 1625

R.D.  
June 17, 2008.

/Rita J. Desai/  
Primary Examiner, Art Unit 1625